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Docket Number (Optional)

8054L-204T (LW8102US/MS)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

June 26, 2006

on

Signature Michael F. MoranoTyped or printed name Michael F. Morano

Application Number

10/790,081

Filed

3/2/04

First Named Inventor

Seong-Bong Kim

Art Unit

1734

Examiner

Brenda A. Lamb

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 44,952Michael F. Morano

Signature

Michael F. Morano

Typed or printed name

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

June 26, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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8054L-204T (LW8102US/MS)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Seong-Bong KIM et al. EXAMINER: Brenda A. Lamb

SERIAL NO.: 10/790,081 GROUP ART UNIT: 1734

FILED: March 2, 2004

FOR: DISCHARGING UNIT FOR DISCHARGING A
PHOTOSENSITIVE MATERIAL, COATER HAVING THE
DISCHARGING UNIT, AND APPARATUS FOR COATING A
PHOTOSENSITIVE MATERIAL HAVING THE COATER

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This paper is being filed with a Notice of Appeal Form (PTO/SB/31) and a Pre-Appeal Brief Request For Review Form (PTO/SB/33).

CERTIFICATE OF MAILING 37 C.F.R. § 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 26, 2006.

Dated: June 26, 2006


Michael F. Morano

REMARKS

Please consider the following reasons for this Pre-Appeal Brief Request For Review.

Claims 27-39 are pending in the above-referenced application. The Examiner indicated that claims 27-33 are allowed and claims 37-39 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph, and to include all of the limitations of the base claim and any intervening claims.

Claims 34-39 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 34-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over (1) U.S. Patent No. 6,398,870 ("Kaya") in view of U.S. Patent No. 3,753,085 ("Morton"); and (2) Kaya in view of Morton, and, if necessary, U.S. Patent Nos. 5,575,852 ("Chase") and 3,924,565 ("Benner").

Claim 34, in pertinent part, reads:

An apparatus for coating a photosensitive layer on a substrate, comprising:

* * *

a coater including a discharging unit for discharging the photosensitive material onto the unit substrate and a transfer unit for moving the discharging unit along a surface of the substrate, the coater coating the photosensitive layer on the substrate by the unit substrate.

REJECTION UNDER 35 U.S.C. § 112

With respect to the rejection under 35 U.S.C. § 112, the Examiner maintains that claim 34 "is confusing due to a typographical error", and states that Applicants should amend claim 34 to recite "the coater coating the photosensitive layer on the substrate

by the discharging unit" instead of "the coater coating the photosensitive layer on the substrate by the unit substrate".

However, the Examiner's requirement that Applicants amend the claim is not necessary and amounts to a clear error in the application of Section 112. The phrase "by the unit substrate" as it is used in claim 34 describes that the photosensitive layer is being coated "per or via each unit substrate."

M.P.E.P. § 2111.01 states "[i]f extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms." (citing *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003). Although the term "by" may be subject to more than one definition, it is clear from Applicants' specification that the word "by" in the phrase "by the unit substrate" is being used as a function word to indicate units or increments. For example, as shown in Applicants' disclosure, the discharging unit may include an outlet divider 131, or a spacer block 250, which is equal to the distance between the unit substrates to cause the layer to be coated only onto the unit substrates 10, 20. See, e.g., Applicants' Disclosure, Figs. 2B, 3, 4, 5A and 5B; and ¶¶ 0015 and 0048-49. Moreover, Applicants' specification states that the photosensitive layer is coated "on a substrate by the unit substrate divided on the substrate." See id. ¶ 0015.

Accordingly, Applicants respectfully submit that it is not necessary to amend claim 34, since claim 34 does not include a typographical error and that the Examiner's indefiniteness rejection of claims 34-39 under 35 U.S.C. § 112 amounts to clear error.

REJECTIONS UNDER 35 U.S.C. § 103

The cited references do not disclose a "coater coating the photosensitive layer on the substrate by the unit substrate", as recited in claim 34.

The Cited References Do Not Disclose Coating By The Unit Substrate

As stated above, the phrase "by the unit substrate" is being used as a function word to indicate units or increments, whereby the configuration of the discharging unit allows the layer to be coated only onto the unit substrates 10, 20.

In contrast to the claimed embodiment, Kaya, Morton, Chase and Benner all disclose spraying devices, which apply a substance in a general location. There is no configuration in the cited references for coating by the unit substrate as claimed.

In the June 5, 2006 Advisory Action, the Examiner maintains that "the Kaya spraying device is capable of coating a certain area/unit/unit substrate of the substrate via a pivoting portion of the coating spray device". However, the marks generated by the devices of Kaya and Morton are in the general location of the defects, and are not applied with the accuracy and precision required to coat by the unit substrate. See, e.g., Kaya, col. 3, lines 6-9 and 64-66 (stating that the piezo pump 32 can be pivoted toward the spot and the marking solution can be applied onto the spot or in the vicinity of the spot).

Moreover, the nature of spraying is such that precision is lost, resulting in scattering of the sprayed material. See, e.g., Morton, col. 3, lines 15-20 (requiring that the spray device S be positioned away from the apparatus A so as to avoid spraying paint on the apparatus A).

Accordingly, Applicants respectfully submit that the cited references do not

disclose coating by the unit substrate, as recited in claim 34.

Marking Devices Are Not Coating Devices

In contrast to the claimed embodiment, Kaya and Morton disclose marking apparatuses, which detect defects on a subject and mark the defects with sprays. The devices in Kaya and Morton spray substances at or near a defect to point out a location of a defect. The marks do not result in a coated layer. See, e.g., Kaya, col. 2, lines 43-51 and Morton, col. 3, lines 11-24.

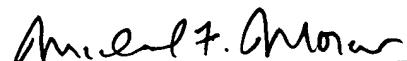
In the June 5, 2006 Advisory Action, the Examiner maintains that “prior art devices apply a non-uniform layer of material on the substrate.” However, Applicants’ disclosure describes coating as a process by which a layer of substance is uniformly applied to portions of a substrate. See, e.g., Fig. 2A, and ¶ 0052 (stating that “coating uniformity of the unit substrate can be improved”).

Accordingly, Applicants respectfully submit that the cited references do not disclose coating, as recited in claim 34.

Therefore, there are clear errors in Examiner’s 103 rejections.

An early and favorable reconsideration is earnestly solicited.

Respectfully submitted,



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